



#3

PATENT S/N 08/584,748

REISSUE PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|---------------------|---|------------------------|---------------|
| Patent Applicant: | LEE ET AL. | Original Patent No.: | 5,637,345 |
| Patent Filed: | JANUARY 11, 1996 | Patent Granted: | JUNE 10, 1997 |
| Reissue App. No.: | 09/933,918 | Patent Group Art Unit: | 1302 |
| Reissue App. Filed: | AUGUST 21, 2001 | Reissue Docket No.: | 8436.18USRE |
| Title: | METHOD OF MANUFACTURING POWDERED DEER BLOOD | | |

CERTIFICATE UNDER 37 CFR 1.10

'Express Mail' mailing label number: EV004049083US

Date of Deposit: July 3, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

By: 

Name: John Junkers

PETITION UNDER 37 C.F.R. § 1.182 TO WITHDRAW THE
ERRONEOUS TERMINAL DISCLAIMER

BOX REISSUE

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:



The undersigned, on behalf of the applicants for the reissue of METHOD OF MANUFACTURING POWDERED DEER BLOOD, U.S. Patent No. 5,637,345 (the '345 patent), granted to applicants on June 10, 1997, respectfully petitions to withdraw the terminal disclaimer dated September 6, 1996, which was filed during prosecution of the '345 patent.

The following facts show that the patent number 5,460,677 (the '677 patent) identified in the September 6, 1996 terminal disclaimer was a clerical error. The correct patent that should have been included in the terminal disclaimer is U.S. Patent No. 5,505,980. The reissue application was filed to correct this error.

Statement of Facts

On January 11, 1996, United States Serial No. 584,748 was filed relating to a method of manufacturing powdered deer blood. The '748 application is a CIP of U.S. Patent No. 5,505,980. In an Office Action dated June 3, 1996, the Examiner made a rejection of claims 1 - 10 of the application under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent No. 5,505,980. A copy of the Office Action is attached as Exhibit A.

In response to the Examiner's Action, a Terminal Disclaimer To Obviate A Double Patenting Rejection was filed on September 6, 1996. The terminal disclaimer inadvertently identified U.S. Patent No. 5,460,677 as the patent beyond which the terminal portion of the present patent would not extend. A copy of the originally filed Terminal Disclaimer, which contains the error, is attached as Exhibit B.

The '677 patent (attached as Exhibit C), however, is neither owned by the applicant nor does it relate to the subject matter contained in the '345 patent. The parent patent, U.S. Patent No. 5,505,980, attached as Exhibit D, which is owned by the applicant, should have been referred to in the September 6, 1996 terminal disclaimer. The '980 parent patent relates to a method of manufacturing powdered deer blood. The unrelated '677 patent relates to a filament winding production method for a micropin array. It is clear from Exhibit A and the other documents in the record that the September 6, 1996 terminal disclaimer should have disclaimed a term not extending past the expiration date of the '980 patent.

The application matured into U.S. Patent No. 5,637,345 when the Examiner mistakenly accepted the terminal disclaimer without noticing the wrong patent number set forth therein.

Applicants filed a reissue application on August 21, 2001 to correct the error. Applicants filed a Corrected Terminal Disclaimer To Obviate A Double Patenting Rejection together with the Reissue application. However, the Examiner advised the applicants that this Petition was necessary to remove the original, incorrect Terminal Disclaimer.

The Examiner also indicated that Applicants Corrected Terminal Disclaimer To Obviate A Double Patenting Rejection was not found in the file. Accordingly, a new Terminal Disclaimer is being filed concurrently with this Petition.

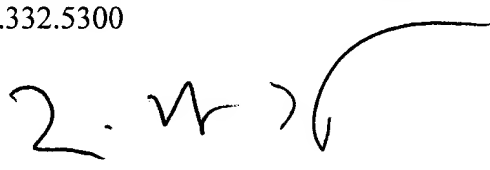
Requested Relief

In view of the above, applicants respectfully request that the September 6, 1996 terminal disclaimer be withdrawn so the Corrected Terminal Disclaimer To Obviate A Double Patenting Rejection, dated July 3, 2002, filed concurrently herewith in the reissue application, can be entered to correct the error.

Respectfully submitted,

MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, Minnesota 55402-0903
612.332.5300

Date 3 July 2002



Brian H. Batzli
Reg. No. 32,960
BHB:PSTjt

Exhibits (as set forth above)



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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|---------------|------------|----------------------|---------------------|
| SERIAL NUMBER | FILED DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---------------|------------|----------------------|---------------------|

08/584,748 01/11/96 LEE

ASM1/0603

MERCHANT GOULD SMITH EDELL
WELTER & SCHMIDT
WESTWOOD GATEWAY II SUITE 400
11150 SANTA MONICA BOULEVARD
LOS ANGELES CA 90025-3395

JRS
Y 08436.180511
EXAMINER
CORBIN, A
ART UNIT PAPER NUMBER
4

1302
DATE MAILED:

06/03/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

Resp 3 Sep 96
Stat 3 Dec 96

☒ This application has been examined ☒ Responsive to communication filed on 2-26-96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-15 are pending in the application.
Of the above, claims 11-15 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-10 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 284,159; filed on 8-2-94.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

JUN - 7 1996

EXAMINER'S ACTION





Serial No. 584748
Art Unit 1302

-2-

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-10, drawn to a method of making powdered deer blood, classified in Class 426, subclass 385.

II. Claims 11-15, drawn to a powdered deer blood product, classified in Class 424, subclass 464.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I. and II. are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by a materially different process, e.g. a process which omits the freezing and ~~cutting~~ steps or just the cutting step.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Janice Sharp on May 24, 1996 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in responding to this Office action.

Claims 11-15 stand withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

6. The Abstract of the Disclosure is objected to because it must be submitted on a separate sheet of paper. Correction is required. See M.P.E.P. § 608.01(b).

7. Claims 1, 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, last line, "down" should be cancelled. Claims 7 and 8 are indefinite since it is not clear what is intended by "towards the end of the freeze drying". At what point in the freeze - drying step does this occur? Corrections are required without new matter.

8. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,505,980. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to eliminate the ethanol addition in the claims of 5,505,980 if deer blood sterilization is not a concern.

9. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*,

Serial No. 584748
Art Unit 1302

-4-

422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

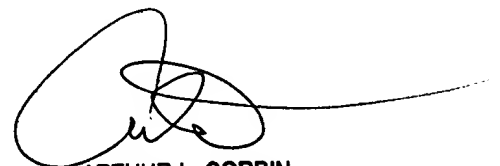
Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Esther Kepplinger, can be reached on (703) 308-2339. The fax phone number for this Group is (703) 305-3601.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Arthur Corbin/om
May 29, 1996

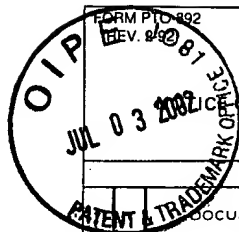


ARTHUR L. CORBIN
PRIMARY EXAMINER
GROUP 1300

5-31-96

NO ADDITIONAL REFERENCES CITED

| FORM PTO-892 REV. 8-81 | | U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE | | SERIAL NO. 584748 | GROUP/ART UNIT 1302 | ATTACHMENT TO PAPER NUMBER 4 | | |
|---|--------------|--|---------|---------------------------|------------------------|--|----------------------------|--------------|
| OFFICE OF REFERENCES CITED | | | | APPLICANT(S) LEE ET AL | | | | |
| U.S. PATENT DOCUMENTS | | | | | | | | |
| | DOCUMENT NO. | DATE | NAME | CLASS | SUB-CLASS | FILING DATE IF APPROPRIATE | | |
| A | | | | | | | | |
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| FOREIGN PATENT DOCUMENTS | | | | | | | | |
| * | DOCUMENT NO. | DATE | COUNTRY | NAME | CLASS | SUB-CLASS | PERTINENT SHTS. DWG. | PP. SPEC. |
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| OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | | |
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| U | | | | | | | | |
| EXAMINER ARTHUR L. CORPIN | | DATE 5-28-96 | | | | | | |
| * A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05 (a).) | | | | | | | | |



FORM 1449*

Docket Number

Application Number

08436.18US11

08/584,748

Applicant

Y. S. Lee et al.

Filing Date

January 11, 1996

Group Art Unit 1302

~~Not Yet Assigned~~INFORMATION DISCLOSURE STATEMENT
IN AN APPLICATION

(Use several sheets if necessary)

U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NO. | DATE | NAME | CLASS | SUBCLASS | FILING DATE IF APPROPRIATE |
|------------------|--------------|------|------------------|-------|----------|----------------------------|
| <i>AL</i> | 4,098,780 | 7/78 | Lindroos | 426 | 647 X | |
| <i>AL</i> | 4,330,463 | 5/82 | Luijterink | 426 | 647 X | |
| <i>AL</i> | 4,446,066 | 5/84 | Luijterink | 426 | 647 X | |
| <i>AL</i> | 4,666,725 | 5/87 | Yamashita et al. | 426 | 647 X | |
| <i>AL</i> | 4,986,998 | 1/91 | Yoo et al. | 426 | 647 | |
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FOREIGN PATENT DOCUMENTS

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| | | | | | | YES | NO |
| <i>AL</i> | 1-211452 | 8/89 | Japan | 426 | 647 | | |
| <i>AL</i> | 1738219 | 6/92 | Su | 426 | 647 | | |
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

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EXAMINER *ARTHUR L. CORBIN*

DATE CONSIDERED 5-23-96

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form for next communication to the Applicant.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Y. S. Lee et al. Examiner: A. Corbin
Serial # : 08/584,748 Group Art Unit: 1302
Filed : January 11, 1996 Docket: 08436.18USI1
Title : HEALTH FOOD PRODUCT INCLUDING POWDER MADE FROM DEER
BLOOD AND A METHOD OF MANUFACTURING THEREFOR

TERMINAL DISCLAIMER TO OBVIATE
A DOUBLE PATENTING REJECTION

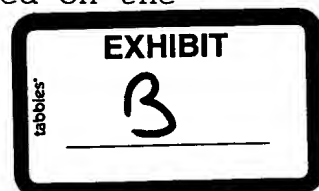
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Petitioners' representative, on behalf of Petitioners, Youn S. Lee, residing at 4 March Place, Belfast, Christchurch, New Zealand; and Hyung S. Lee, residing at 125-3 Kalak-Dong, Songpa-Ku, Seoul, Korea, represents that National Deer Horn Limited having a place of business at 4 March Place, Belfast, Christchurch, New Zealand, is the owner of the entire right, title and interest in U.S. Patent Application Serial No. 08/584,748, filed on January 11, 1996 and entitled, HEALTH FOOD PRODUCT INCLUDING POWDER MADE FROM DEER BLOOD AND A METHOD OF MANUFACTURING THEREFOR.

Petitioners' representative hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,460,677 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,460,677, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors, or assigns.

In making the above disclaimer, Petitioners' representative does not disclaim the terminal part of any patent granted on the



above-identified application that would extend to the full statutory term as presently shortened by any terminal disclaimer of U. S. Patent No. 5,460,677, in the event that any such issued patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims cancelled by a reexamination certification, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date

September 6, 1996

Janice Sharp
Attorney for Applicants
Registration No. 34,051

- [x] Please charge Deposit Account No. 13-2724 any fees necessary for this Terminal Disclaimer.

THE STATEMENT BELOW IS FOR OFFICE USE ONLY

In accordance with the decision granting the Petition filed on _____, 19 __, this Terminal Disclaimer ~~is~~ accepted. The period of patent lapse specified above has been accepted as equivalent to _____ months.

Date

Petitions Examiner

RECEIVED

JUL 15 2002

OFFICE OF PETITIONS